

### REMARKS/ARGUMENTS

Upon entry of the foregoing amendments, claims 31-38 and 45-50 will be pending in the above-identified patent application. Claims 39-44 and 51-56 have been cancelled, without prejudice to their presentation in a continuation application.

#### **Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 39-44 and 51-56 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Although Applicant believes that claims 39-44 and 51-56 particularly point out and distinctly claim the subject matter which he regards as his inventions, they have been cancelled to advance prosecution. Accordingly, Applicant respectfully submits that the rejection is now moot.

#### **Rejections Under the Judicially-Created Doctrine of Obviousness-Type Double Patenting**

Claims 31-44 have been rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-12 of commonly-owned U.S. Patent No. 6,184,389 ("the 389 Patent"). Claims 45-56 have been rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-12 of the 389 Patent in view of either of U.S. Patent No. 5,112,962 to Letsinger, *et al.*, ("the Letsinger patent") or U.S. Patent No. 5,015,733 to Smith, *et al.* ("the Smith patent").

Claims 31-56 have been rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-47 and 50-54 of commonly-owned U.S. Patent No. 6,448,373 to Hebert ("the Hebert patent") or, alternatively,

over claims 1-47 and 50-54 of the Hebert patent in view of either the Letsinger patent or the Smith patent.

Claims 31-44 have been rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-22 of commonly-owned U.S. Patent No. 5,886,177 ("the 177 Patent"). Claims 45-56 have been rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-22 of the 177 Patent in view of either the Letsinger patent or the Smith patent.

Although Applicant does not necessarily concur with the rationale underlying these rejections, suitable terminal disclaimers are submitted rendering the rejections moot.

**Rejections Under 35 U.S.C. § 103(a)**

Claims 31-38 and 45-56 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Hebert patent taken alone, or in combination with either the Letsinger patent or the Smith patent. Applicant respectfully traverses this rejection because the Examiner has failed to show that one of ordinary skill in the art would have been motivated to modify the teaching of the Hebert patent to obtain any claimed inventions.

Patent claims cannot be found obvious in view of a combination of references unless the prior art itself suggests the desirability of the combination. *Berghauser v. Dann*, 204 U.S.P.Q. 393 (D.D.C. 1979); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929 (Fed. Cir. 1984). "A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313.

1316 (Fed. Cir. 2000). To establish a *prima facie* case of obviousness, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

No such showing has been made with respect to Applicant's claims. In this regard, the Examiner is mistaken with respect to his assertion that the Office Action mailed on November 7, 2002, identified compounds in the Hebert Patent that are within the scope of the instant claims (Office Action mailed on June 17, 2003, at pages 8-9). The prior Office Action simply demonstrated that it is possible with the benefit of hindsight to make choices among the many variables set forth in the Hebert Patent that would result in claimed compounds. Neither Office Action has identified any reason that one of ordinary skill *without* the benefit of hindsight would have been motivated to make those choices or otherwise would have been led to the claimed inventions. In the absence of any evidence of motivation to alter the teaching of the prior art in a way that would have resulted in a claimed invention, the rejection for alleged obvious is improper and should be withdrawn.

The Office Action at page 9 appears to assert generic claims such as those found in the cited references "motivate as well as suggest specifically" species that fall within their scope. If this is, in fact, what is being asserted, Applicant respectfully requests that the Examiner identify supporting legal authority, since it is believed that the applicable law is

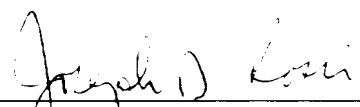
DOCKET NO.: ISIS-2297  
Application No.: 08 973,381  
Office Action Dated: June 17, 2003

PATENT  
REPLY FILED UNDER EXPEDITED  
PROCEDURE PURSUANT TO  
37 CFR § 1.116

directly to the contrary. Indeed, it is well established that the disclosure of a genus of the magnitude found in the cited reference cannot itself render species within its scope obvious. *In re Jones*, 958 F.2d 347, 350, 21 U.S.P.Q.2d 1941, 1943 (Fed. Cir. 1992) (rejecting Commissioner's argument that "regardless [ ] how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it").

Applicants believe that this application is now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance are respectfully requested.

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